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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/650,615

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Hitoshi Suzuki

16987

8298

23389

7590

11/02/2009

SCULLY SCOTT MURPHY & PRESSER, PC

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GARDEN CITY, NY 11530

EXAMINER

COBANOGILU, DILEK B

ART UNIT

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3626

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/650,615

**Applicant(s)**

SUZUKI ET AL.

**Examiner**

DILEK B. COBANOGU

**Art Unit**

3626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27 and 31-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/27/2009 has been entered.
2. Claims 27, 31-39 remain pending in this application.

### ***Specification***

#### ***Claim Objection***

3. Claim 27 is objected to because of the following informalities: Claim 27 recites "...an unscheduled medical job data input/output unit inputting and outputting **data of medical activities unscheduled** and not transmitted as instructions from said server system; wherein the data of unscheduled medical activities is medicine name data indicating a name of a medicine in a broken injection bottle". There is insufficient antecedent basis for "the data of unscheduled medical activities", because it's slightly different than "**data of medical activities unscheduled**". Appropriate correction is required.

### ***New Matter***

4. The amendment filed 8/27/2009 is objected under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment

shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

5. The newly added recitation of "an arithmetic processing unit" within claims 32, 33, 34, 37, 38 and 39. In particular, Applicant does not point to, nor was the Examiner able to find, any support for "an arithmetic processing unit" within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.
6. Applicant is required to cancel the new matter in the reply to this office action.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 32, 33, 34, 37, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above. Independent claims 32, 33, 34, 37, 38 and 39 recite limitations that are new matter, as discussed above.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language "data indicating a name of a medicine in a broken injection bottle" in claim 27 is static and brings no structural distinction; the language is considered nonfunctional descriptive material related to information stored in a terminal (or computer). This data does not change any process in the claims. It is unclear if the data indicating a name of a medicine in a broken injection bottle is for inventory purpose or recording/reporting an error in the medication container.

11. The descriptive material does not make a system part (terminal, server or hospital management system) to make a process. See MPEP 2106.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**NOTE:** The following rejections assume that the subject matter added in 8/27/2009 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 4-8 above in the next communication sent in response to the present Office Action.

13. Claims 27, 32-39 are rejected under 35 U.S.C. 102(a) as being unpatentable by Sasaki (JP, 09-245093, A, Portable Nursing Job Supporting System).

A. Claim 27 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal inputting and outputting data relating to medical activities (Sasaki; par. 0001, 0010);
- ii. a server system communicating the data with said terminal (Sasaki; par. 0016); and
- iii. a hospital information management system recording information communicated by said server system in the hospital, and centrally managing the information (Sasaki; par. 0010, 0020),

wherein said terminal comprises:

a scheduled medical job data input/output unit inputting and outputting data of medical activities normally scheduled and transmitted as instructions from said server system according to a medical order (Sasaki; par. 0001, 0020); and

an unscheduled medical job data input/output unit inputting and outputting data of medical activities unscheduled and not transmitted as instructions from said server system wherein the data of unscheduled medical activities is medicine name data indicating a name of a medicine in a broken injection bottle (Sasaki; par. 0020, 0027, 0028, 0038).

Sasaki does not specifically mention a broken injection bottle. However, these differences are only found in the nonfunctional descriptive material and do not alter the functions of inputting, receiving, searching, matching, transmitting and outputting data. The descriptive materials do not alter how Sasaki functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2<sup>nd</sup> 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

B. Claim 32 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal including an arithmetic processing unit, and inputting and outputting data via the arithmetic processing unit executing an application program (Sasaki; par. 0001, 0010, 0017); and
- ii. a server system communicating the data with said terminal (Sasaki; par. 0010, 0016, 0017);

wherein: when a request to terminate a connection between said terminal and said server system is received from said terminal, said server system transmits, to said terminal, data for update of an application program being executed by the arithmetic processing unit which said terminal includes (Sasaki; par. 0024, 0029, 0035); and

said terminal updates the application program being executed by the arithmetic processing unit which the terminal includes, based on the

data transmitted from said server system and used for the update (Sasaki; par. 0024, 0029, 0035).

C. Claim 33 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal including an arithmetic processing unit, and inputting and outputting data via the arithmetic processing unit executing an application program (Sasaki; par. 0001, 0010); and
- ii. a server system communicating the data with said terminal (Sasaki; par. 0010);

wherein: said terminal updates the application program being executed by the arithmetic processing unit which said terminal includes, based on the data transmitted from said server system and used for update of the application program (Sasaki; par. 0020, 0027);

when the request for a connection between said terminal and said server system is transmitted from said terminal, said server system transmits information about availability of the updated application program to said terminal (Sasaki; par. 0020); and

when the information transmitted from said server system indicates that the updated application program is available, said terminal allows the arithmetic processing unit to execute the updated application program, and inputs and outputs the data (Sasaki; par. 0020).



D. Claim 34 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal including an arithmetic processing unit, and inputting and outputting data via the arithmetic processing unit executing an application program (Sasaki; par. 0001, 0010); and
- ii. a server system communicating the data with said terminal (Sasaki; par. 0020, 0024);

wherein: said server system contains data for use in updating an application program being executed by the arithmetic processing unit which said terminal includes, and can set in said server system a starting date from which the terminal can execute the updated application program via the arithmetic processing unit (Sasaki; par. 0020, 0024);

said terminal is configured to update the application program based on the data transmitted from said server system for use in the update (Sasaki; par. 0024, 0029);

when said server system is connected to said terminal before the set starting date and the data for use in the update is not transmitted from said server system to said terminal, said server system transmits the data to the terminal to store the data in (Sasaki; par. 0024, 0029);

when said server system is connected to said terminal after the set starting date and the data for use in the update is transmitted from said server system to said terminal, said server system allows said terminal to

update the application program based on the data (Sasaki; par. 0024, 0029); and

when said server system is connected to said terminal after the set starting date and the data for use in the update is not transmitted from said server system to said terminal, said server system transmit the data to said terminal and allows said terminal to store the data and update the application program based on the data (Sasaki; par. 0024, 0029).

E. As per claim 35, Sasaki discloses the system according to claim 32, wherein data input and output by said terminal relates to medical activities (Sasaki; par. 0001, 0020).

F. As per claim 36, Sasaki discloses the system according to claim 32, wherein said terminal ignores other input to said terminal when said terminal receives data from said server system for use in updating the program (Sasaki; par. 0020, 0024, 0035).

G. Claim 37 has been amended now to recite a server system which is a component of an information system for use in a hospital, comprising:

- i. a data communications device communicating data with a terminal which is a component of the information system, includes an arithmetic processing unit, and inputs and outputs data via the arithmetic processing unit executing an application program (Sasaki; par. 0001, 0020); and
- ii. an update data transmission unit transmitting, to the terminal, data for use in updating an application program being executed by the

arithmetic processing unit which the terminal includes, when a request to terminate a connection is received from the terminal (Sasaki; par. 0024, 0029, 0034).

H. Claim 38 has been amended now to recite a server system which is a component of an information system for use in a hospital, comprising:

i. a data communications device communicating data with a terminal which is a component of the information system, includes an arithmetic processing unit, and inputs and outputs data via the arithmetic processing unit executing an application program (Sasaki; par. 0001, 0020);

ii. an update data transmission unit transmitting, to the terminal, data for use in updating an application program being executed by the arithmetic processing unit which the terminal includes (Sasaki; par. 0024, 0029, 0035); and

iii. a program availability information transmission unit transmitting, to the terminal, information indicating whether or not and application program after update can be executed via the arithmetic processing unit which the terminal includes, when a request for a connection is received from the terminal (Sasaki; par. 0024, 0029, 0035).

I. Claim 39 has been amended now to recite a terminal which is a component of an information system for use in a hospital, comprising:

i. an arithmetic processing unit (Sasaki; par. 0001, 0020);

- ii. an input/output unit inputting and outputting data via the arithmetic processing unit executing an application program (Sasaki; par. 0001, 0020);
- iii. a data communications device communicating the data with a server system which is a component of the information system (Sasaki; par. 0001, 0020); and
- iv. an application program update unit updating the application program based on data transmitted from the server system for use in updating the application program (Sasaki; par. 0024, 0029),

wherein said input/output unit inputs and outputs data by allowing the arithmetic processing unit to execute executing an updated application program when information transmitted from the server system at a request transmitted to the server system to connect to the server system indicates permission of execution availability of the updated application program via the arithmetic processing unit which the terminal includes (Sasaki; par. 0024, 0029, 0035).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki (JP, 09-245093, A, Portable Nursing Job Supporting System) in view of White et al. (hereinafter White) (U.S. Patent No. 6,790,198 B1).

A. Claim 31 has been amended to recite the system according to claim 27, wherein said unscheduled medical job data input/output unit inputs the name of the medicine in the broken injection bottle by reading an identification code attached to the injection bottle by an identification code reader provided for said terminal, or by a user of said terminal manually inputting the code.

Sasaki fails to expressly teach "reading an identification code attached to the injection bottle by an identification code reader provided for said terminal, or by a user of said terminal manually inputting the code". However, this feature is well known in the art, as evidenced by White. In particular, White discloses this feature (White; col. 9, lines 35-58). It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by White with the motivation of comparing patient information to the label on the physical container (White; col. 9, lines 46-47).

### ***Response to Arguments***

16. Applicant's arguments filed 8/27/2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about Sasaki does not teach "any broken injection bottle", Examiner respectfully submits that "a broken injection bottle" represent a nonfunctional descriptive material related to information stored in the terminal as explained above in 101 and claim rejection of claim 27. The language "...broken injection bottle..." refers to actions that take place outside the metes and bounds of the claims and carries little to no patentable weight.

B. In response to Applicant's argument about Sasaki does not teach newly added term "arithmetic processing unit"; Examiner respectfully submits that this term constitutes a new matter as explained above in section 4-8. Furthermore, if Applicant believes that "an arithmetic processing unit" or "an arithmetic logic unit" (described in the Microsoft <sup>TM</sup> computer dictionary as: a component of microprocessor chip used for arithmetic, comparative and logical functions) is inherent in a computer system, therefore since Sasaki teaches a computer system, Sasaki teaches "an arithmetic processing unit" as well.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DILEK B. COBANOGLU whose telephone number is (571)272-8295. The examiner can normally be reached on 8-4:30.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dilek B Cobanoglu/  
Examiner, Art Unit 3626  
10/29/2009